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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,717	11/21/2001	Victor Wiener	101351-21	1000
21125 7590 05/16/2008 NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604				
EXAMINER ELAHEE, MD S				
ART UNIT		PAPER NUMBER		
2614				
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05/16/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

# Office Action Summary

**Application No.**

09/990,717

**Applicant(s)**

WIENER ET AL.

**Examiner**

MD S. ELAHEE

**Art Unit**

2614

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02/11/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SI/005)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed 02/11/2008. Claims 40-89 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed on 02/11/2008 remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

### ***Claim Objections***

3. Claims 40, 41 and 70 are objected to because of the following informalities: regarding claim 40, the phrase "said A and B parties" in line 8 should apparently be "said A party and said B party". Claims 41 and 70 are objected for the same reasons as discussed above with respect to claim 40. Appropriate correction is required.
4. Claim 56 is objected to because of the following informalities: regarding claim 56, the phrase "an A party and a B party" in line 9 should apparently be "said A party and said B party". Appropriate correction is required.
5. Claim 79 is objected to because of the following informalities: regarding claim 79, the phrase "a call" in line 8 should apparently be "the call". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 40, 41, 42/40,42/41, 43-46, 47/40,47/41,47/45, 47/46, 48,49,56-58, 59/56,59/57, 60,61, 62/60,62/61, 63, 64/60,64/61, 65/60,66/61, 67/60,67/61, 68-71, 72/69,72/70, 73-87,

88/40,88/41,88/45,88/46,88/73, 89/40,89/41,89/45,89/46,89/73 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sussman** (US 5,483,586) in view of **Bateman et al.** (US 5,884,032).

As to Claims 40,41,45,46,56,57,69,70, with respect to Figures 1-2, **Sussman** teaches a method of establishing a communications call, including:

enabling an A party to select a B party from a database using an interactive device connected to a public network, said public network comprising an Internet messaging network (Figure 1, 2; Col. 3, lines 66,67, Col. 4, lines 1-6, 60-63, Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17);

utilizing said network to access called address data for said B party from a public directory of said public network in response to selecting said B party (Col. 5, lines 47-55, Col. 6, lines 25-34). However, **Sussman** does not specifically teach utilizing said Internet messaging network to access called address data for said B party. **Bateman** teaches utilizing said Internet messaging network to access web pages [i.e., called address data] for said B party (Col. 6, lines 31-45). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Sussman** to utilizing said Internet messaging network to access called address data for said B party as taught by **Bateman**. The motivation for the modification is to have doing so in order to access subscriber address using internet in a cheaper rate.

**Sussman** further teaches sending said called address data for said B party and calling address data for the A party to a connection module of said public network (Col. 5, lines 47-55, Col. 6, lines 25-34); and

**Sussman** further teaches establishing a call between said A and B parties over said public network using said connection module and said called and calling address data (Col. 2, lines 28-30, Col. 5, lines 47-55).

As to Claim 42/40, 42/41, **Sussman** teaches a method as claimed in claims 40 or 41, wherein said interactive device is a computer and/or telephony device including a visual display (Figure 2; Col. 5, lines 17-24).

As to Claim 43, **Sussman** teaches a method as claimed in claim 40, wherein said interactive device is associated with said A party (Figure 2).

As to Claim 44, **Sussman** teaches a method as claimed in claim 40, wherein said interactive device is a communications terminal for said call (Figure 2; Col. 5, lines 17-24).

As to Claims 47/45, 47/46, **Sussman** teaches a method as claimed in claims 45 or 46, wherein said public network further comprises at least one public telecommunications network, 9, for connecting said A and B parties (Figure 1).

As to Claim 48, **Sussman** teaches a method as claimed in claim 47, wherein said messaging network provides said interactive device with a plurality of B party data (Col. 6, lines 32-45).

As to Claim 49, **Sussman** teaches a method as claimed in claim 47, wherein said messaging network accesses and forwards said called address data to said telecommunications network (Col. 3, lines 66,67, Col. 4, lines 1-6, 60-63, Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

As to Claims 52,58, **Sussman** teaches an interface as claimed in claim 51, wherein said results includes called address data for said B party data, and said selected party data includes said called address data (Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

As to Claims 53/50,53/51, **Sussman** teaches an interface as claimed in claims 50, 51 or 52, wherein said interface is sent to said interactive device by said public network on request from said interactive device (Figure 2; Col. 5, lines 17-24).

As to Claims 54-55, **Sussman** teaches an interface as claimed in claim 51, wherein said public network further comprises at least one public telecommunications network for establishing said call (Figure 1).

As to Claims 59/56,59/57, **Sussman** teaches an interface as claimed in claims 56 or 57, wherein said public network further comprises at least one public switched telephone network for establishing said call (Figure 1). However, **Sussman** does not specifically teach that said messaging network of the public network includes a TCP/IP messaging network. **Bateman** teaches that said messaging network of the public network includes a TCP/IP messaging network

(Col. 6, lines 31-45). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Sussman** to incorporate said messaging network of the public network including a TCP/IP messaging network as taught by **Bateman**. The motivation for the modification is to have doing so in order to access subscriber information via internet and thereby saving money and time.

Claim 61 is rejected for the same reasons as discussed above with respect to claim 40. Furthermore, with respect to Figures 1-2, **Sussman** teaches a system for use in establishing a communications call, including:

a network controller for receiving said called address data and calling address data corresponding to the A party and generating, in response thereto, network control signals to cause said at least one public network to establish a call between said A party and said B party over said network (Col. 2, lines 28-30, Col. 5, lines 47-55).

As to Claim 62/61, **Sussman** teaches a system as claimed in claim 60 or 61, wherein said network includes at least one public telecommunications network, such as a PSTN, for receiving said control signals and establishing said call, and wherein the messaging network comprises the Internet, for passing data between the A party, the access module and the network controller (Figures 1,2; Col. 2, lines 28-30, Col. 5, lines 47-55).



As to Claim 63, **Sussman** teaches a system as claimed in claim 61, wherein the access module includes directory data from said directory database for display by said A party (Col. 5, lines 48-55 and Col. 6, lines 26-34).

As to Claims 64/61, **Sussman** teaches a system as claimed in claims 60 or 61, including a search module accessible by said A party over said network for searching said directory database (Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

As to Claims 65/61, **Sussman** teaches a system as claimed in claims 60 or 61, wherein said call is established with a terminal of the A party which selects said selected B party (Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

As to Claims 66/61, **Sussman** teaches a system as claimed in claims 60 or 61, wherein said call is established with a terminal of the A party which is separate from the terminal selecting said B party (Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

As to Claims 67/61, **Sussman** teaches a system as claimed in claims 60 or 61, wherein the address data includes a party terminal number (Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17). However, **Sussman** does not specifically teach security information. **Bateman** teaches security information (Col. 6, lines 44-50). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Sussman** to incorporate

security information as taught by **Bateman**. The motivation for the modification is to have doing so in order to receive security information such that a user can easily access secured data.

As to Claim 68, **Sussman** teaches a system as claimed in claim 60, wherein at least one of the calling address data and the called address data includes account information (Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

As to claim 71, **Sussman** teaches a server as claimed in claim 70, including a directory database module for accessing directory data, including communications address data, of parties connected to at least said public network, wherein the communications address data of said connect message for at least said B party is obtained using said directory database module (Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

Claims 73,77 are rejected for the same reasons as discussed above with respect to claim 40. Furthermore, with respect to Figures 1-6, **Sussman** teaches a method of establishing a call between parties, including:

generating a second message in response to said first message, said second message including communication addresses determined on the basis of said identification data by accessing a public directory via said messaging network (Col. 2, lines 28-30, Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

As to Claims 74,78, **Sussman** teaches a method as claimed in claim 73, wherein the identification data is name data (Col. 6, lines 25-34).

As to Claim 75, **Sussman** teaches a method as claimed in claim 73, wherein the directory service is adapted to access a database of public communications addresses stored against respective identification data (Col. 6, lines 25-34).

As to Claim 76, **Sussman** teaches a method as claimed in claim 73, wherein selection of the displayed element invokes generation of code on the interactive device to generate and send the first message (Col. 3, lines 9-13, Col. 5, lines 47-55, Col. 6, lines 25-34, Col. 7, lines 13-17).

As to Claims 88/40,88/41,88/45,88/46,88/73, **Sussman** teaches a network system having components for executing the steps of a method as claimed in claims 40, 41, 45, 46, 73 (Col. 3, lines 9-13, Col. 5, lines 47-55, Col. 6, lines 25-34, 40-59).

As to Claims 89/40,89/41,89/45,89/46,89/73, **Sussman** teaches a Computer software having code for executing the steps of a method as claimed in claims 40, 41, 45, 46, 73 (Col. 3, lines 9-13, Col. 5, lines 47-55, Col. 6, lines 25-34, 40-59).

10. Claims 40,41,45,46,56,57,61,69,70,73,77 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Padden et al.** (US 4,979,206) in view of **Bateman et al.** (US 5,884,032).

As to Claims 40,41,45,46,56,57,69,70, with respect to Figures 1-6, **Padden** teaches a method of establishing a communications call, including:

enabling an A party to select a target customer (a B party) from a database using a VRU (an interactive device) connected to a public network, said public network comprising a messaging network (Figure 1 and Col. 6, lines 49-60);

utilizing said messaging network to access called address data for said B party from a public directory of said public network in response to selecting said B party (Col. 6, lines 60-67 and Col. 7, lines 1-7);

sending said called address data for said B party and calling address data for the caller (the A party) to control 10 (a connection module) of said public network (Col. 7, lines 3-15); and

establishing a call between said A and B parties over said public network using said connection module and said called and calling address data (Col. 7, lines 11-14).

**Padden** discloses voice and data switching network 12 (fig.1) as a messaging network since voice message is being transmitted through the network (see Col. 6, lines 49-60). However, **Padden** does not specifically teach messaging network is an internet messaging network. **Bateman** teaches that messaging network is an internet messaging network (Col. 6, lines 31-45). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Padden** to incorporate messaging network as an internet messaging network as taught by **Bateman**. The motivation for the modification is to have doing so in order to download subscribers lists to a user device such that the user can browse through the lists.

Claim 61 is rejected for the same reasons as discussed above with respect to claim 40. Furthermore, with respect to Figures 1-6, **Padden** teaches a system for use in establishing a communications call, including:

a network controller for receiving said called address data and calling address data corresponding to the A party and generating, in response thereto, network control signals to cause said at least one public network to establish a call between said A party and said B party over said network (Col. 5, lines 50-68).

Claims 73,77 are rejected for the same reasons as discussed above with respect to claim 40. Furthermore, with respect to Figures 1-6, **Padden** teaches a method of establishing a call between parties, including:

generating a second message in response to said first message, said second message including communication addresses determined on the basis of said identification data by accessing a public directory via said messaging network (Col. 5, lines 50-68, Col. 6, lines 60-67 and Col. 7, lines 1-14).

11. Claims 50,51,60 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Padden et al.** (US 4,979,206) in view of **Bateman et al.** (US 5,884,032) further in view of **Sussman** (US 5,483,586).

As to Claims 50-51,60 are rejected for the same reasons as discussed above with respect to claim 40. Furthermore, with respect to Figures 1-6, **Padden** teaches an interactive device for originating a communications call, including:

a display controller for causing display of a desired directory number (at least one B party) (Col. 5, lines 14-18);

an operator (selector) for enabling an A party to select a B party on said display (Col. 5, lines 20-30); and

data link 54 (a link) which on being activated sends selected party data corresponding to said B party to a DAS/C computer (public network),

whereby said public network accesses called address data of said B party in a public directory via a messaging network on the basis of said selected party data and forwards said called address data to connection module of said public network to establish a call with said B party (Col. 5, lines 50-68).

However, **Padden** in view of **Bateman** does not specifically teach displaying of at least one B party from a database to an A party. **Sussman** teaches displaying of at least one B party from a database to an A party (Col. 5, lines 48-55 and Col. 6, lines 26-34). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Padden** in view of **Bateman** to display of at least one B party from a database to an A party as taught by **Sussman**. The motivation for the modification is to do so in order to make a selection from a list displayed on his own terminal.

*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MD SHAFIUL ALAM ELAHEE  
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